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Supreme Court of the United States

OCTOBER TERM, 1941

No. 1024

TAMPAX INCORPORATED and TAMPAX
SALES CORPORATION

Petitioners

vs.

THE PERSONAL PRODUCTS CORPORATION and
ISIDORE H. SCHWARTZ, trading as HIGHLAND
PHARMACY

Respondents

**PETITION FOR WRIT OF CERTIORARI TO THE
CIRCUIT COURT OF APPEALS FOR THE SECOND
CIRCUIT AND BRIEF IN SUPPORT THEREOF**

H. STANLEY MANSFIELD
W. BROWN MORTON

Counsel for Petitioners



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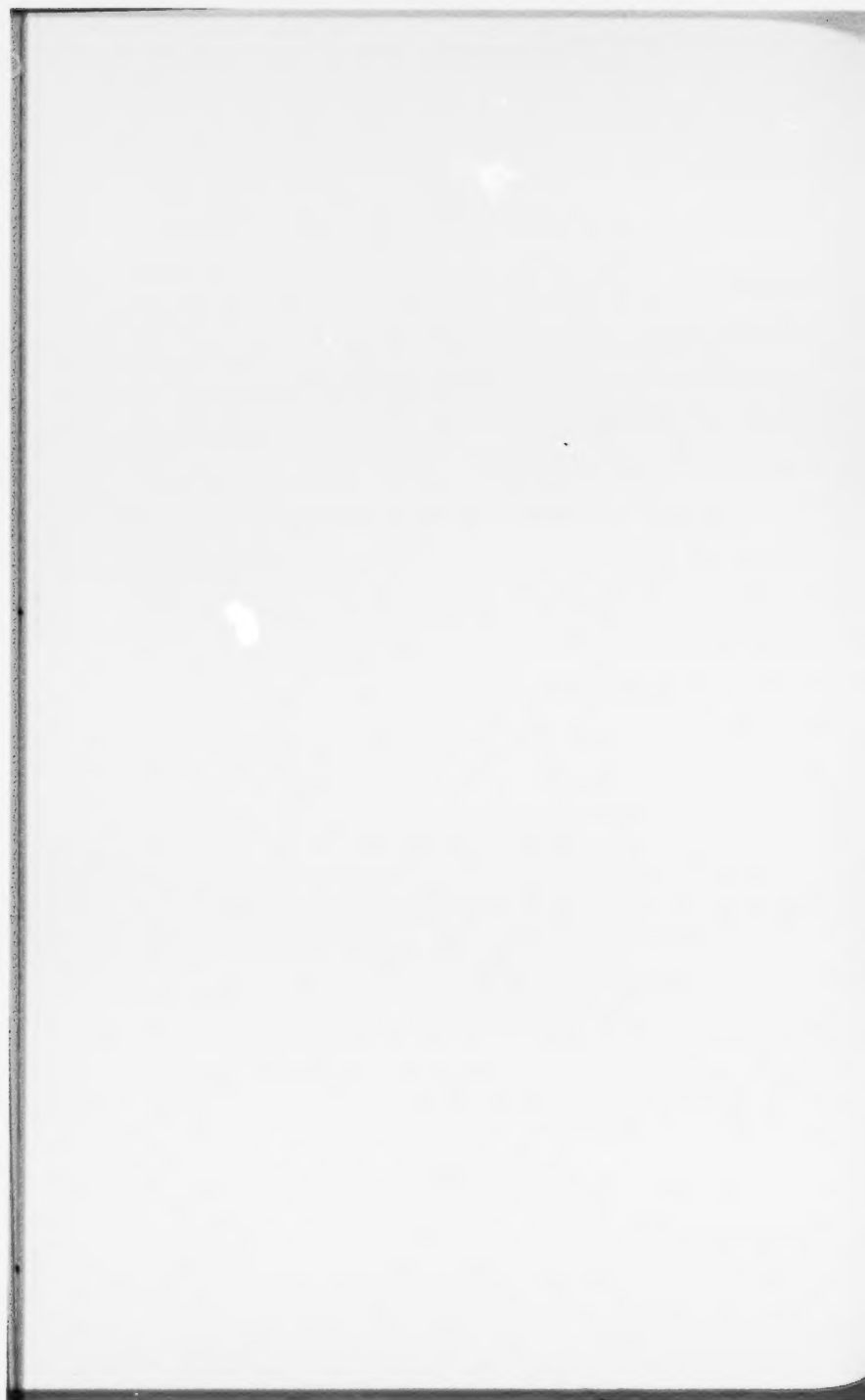
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Respondents

PETITION FOR WRIT OF CERTIORARI

*To the Honorable, the Chief Justice and the Associate
Justices of the Supreme Court of the United States:*

Your petitioners, Tampax Incorporated and Tampax Sales Corporation, pray that a writ of certiorari issue to review the decision of the United States Circuit Court of Appeals for the Second Circuit entered herein on the 24th day of November, 1941 (R. 505). Rehearing and reconsideration by that Court were requested and were denied on the 10th day of December, 1941 (R. 518).

A certified transcript of the record of the case, including the proceedings in the Circuit Court of Appeals, is furnished herewith in compliance with Rule 38 of this Court.

Opinions Below

The opinion of the District Court appears in 38 F. Supp. 663, and the opinion of the Circuit Court of Appeals for the Second Circuit in 123 F. (2d) 722.

Summary Statement of the Matter Involved

This is a suit in equity brought by petitioners against respondents in the United States District Court for the Eastern District of New York for, *inter alia*, alleged infringement of claim 1 of U. S. patent No. 1,964,911, granted July 3, 1934. The District Court held claim 1* valid but not infringed, and entered the usual decree dismissing the complaint. On appeal to the Circuit Court of Appeals for the Second Circuit the decree was affirmed. In its opinion the Court of Appeals based its finding of non-infringement on the ground of "file wrapper estoppel", asserting that by the proceedings in the Patent Office the claim is limited to the precise embodiment illustrated in the drawings, notwithstanding the fact that the claim is expressed in broader terms which are definite and unambiguous.

The Patent Office proceedings which the Court of Appeals for the Second Circuit held to create a "file wrapper estoppel" was not an amendment to the claim to secure its allowance. The claim was one of the original claims of the application on which the patent was granted and there was no significant amendment of any sort during the prosecution of that application.

The "file wrapper estoppel" found by the Court of Appeals is based on the inclusion in the specification and drawing of the application for the patent of a more detailed disclosure of the specific article of the patent than was included in the specification and drawing of a prior pending application of the same inventor in which the same claim was presented but not allowed.

*1. A catamenial device comprising: a highly compressed, self-sustaining, absorbent core; and a flexible member secured to and depending from said core to form a withdrawing member, said core comprising a compressed, convoluted strip of absorbent material, said core being considerably shorter than said strip (R. 182).

The application* upon which the patent issued was filed as a continuation in part of an earlier application** filed by the same inventor. The claim in issue was originally presented in the earlier application and was rejected in that application on the ground that the subject-matter of the claim was not sufficiently disclosed in the specification and drawing (R. 282). The applicant thereupon filed a second application with an amplified description and drawing and with the exact claim previously presented in the earlier application. The Court of Appeals for the Second Circuit held that the filing of the second application with the amplified disclosure was analogous to amplifying the disclosure of the first application by amendment and created a "file wrapper estoppel" which required that the claim be limited to the precise embodiment of the invention illustrated in the amplified disclosure notwithstanding the fact that the terms of the claim as clearly defined in the specification required a broader construction.

Question Presented

The question presented by this case is the following:

Does the amplification of the specification and drawing, whether by amendment or by a "continuing" application, to show in greater detail the preferred embodiment of the invention, restrict the scope of the claims to the added details?

Reasons for Granting the Writ

1. The ruling of the Court of Appeals for the Second Circuit denying to the patentee the benefit of a range of equivalents within the scope of the language of the claim

*Ser. No. 672,145, filed May 22, 1933. Pat. No. 1,964,911 (R. 191).

**Ser. No. 576,179, filed Nov. 19, 1931. Pat. No. 1,926,900 (R. 256).

is in direct conflict with the ruling of this Court in *Exhibit Supply Co. v. Ace Patents Corporation*, decided February 2, 1942 (86 L. Ed. 453, Advance Sheets).

2. The ruling of the Circuit Court of Appeals for the Second Circuit that additions to the specification and drawings to illustrate a preferred embodiment of the invention in greater detail creates a file wrapper estoppel which limits the claim to the precise details so added, is in direct conflict with the following decisions of the Courts in the First and Third Circuits.

Manhattan General Construction Co. v. Helios-Upton Co., 135 Fed. 785 (C. C. E. D. Pa.);
A. S. Boyle Co. v. Siegel Hardware & Paint Co.,
26 F. Supp. 217 (D. C. Mass.).

3. A decision on the questions here presented is of importance to the public interest. The disclosure of the invention is the consideration paid by the patentee for the limited monopoly of his patent. It is to the public interest that that disclosure include all the necessary detail for the commercial production of the patented article. When the disclosure is insufficient the Patent Office requires additional drawings and description, but patentees will limit their compliance to the least that is acceptable if they thereby limit the scope of the patent beyond the terms of their claims.

WHEREFORE, it is respectfully requested that this petition for a writ of certiorari to the Circuit Court of Appeals for the Second Circuit be granted.

H. STANLEY MANSFIELD
W. BROWN MORTON
Counsel for Petitioners

Dated: New York, N. Y.
March 6, 1942.

